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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/565,982 | 01/26/2006 | Melchor Daumal Castellon | 001058-00031 | 9466 |
| 27557 7590 08/26/2010 BLANK ROME LLP WATERGATE 600 NEW HAMPSHIRE AVENUE, N.W. WASHINGTON, DC 20037 | | | | |
| EXAMINER | | | | |
| DIAZ, THOMAS C | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/565,982

Applicant(s)

DAUMAL CASTELLON, MELCHOR

Examiner

THOMAS DIAZ

Art Unit

3656

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-6, 9, 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-6, 9 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05/21/2009 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/13/2010 has been entered.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "deformations" of claim 2 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate

changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 1 and 5 are objected to because of the following informalities: The claims contain the language "adapted for". This language should be deleted since the male member is being positively claimed in the rest of the claims. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4-6, 9, 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Reiche et al. (USP 7174803).

Regarding claim 1, Reiche et al. discloses an intermediate shaft assembly comprising a female member (fig.5, 3) [adapted for slidably receiving a male member] therein, said female and male members (fig.5, 2) having a substantially triangular shape with blunt vertexes (see fig.6, both members have a substantially triangular shape with blunt vertexes), and at least one metal strip (fig.5, metal strips 9) that is separate from the male member fitted therebetween having an uneven contact surface (the strips are uneven or not flat, furthermore any contact surface can be read as uneven since all contact surfaces have surface roughness and thus are uneven), characterized in that said metal strip is fitted between the male member and the female member and inside at least one recess (see figures 5 and 6, the strips are fitted between the members and in a recess 8) in a fastening cage (fig.6, 7) clamped to the external surface of said male member (the cage is clamped between the male and female members).

Regarding the functional recitation(s) in the claim(s) denoted by the "[]" the examiner notes while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. The reference discloses all the claimed structural limitations and therefore anticipates the claim. See MPEP 2114. Additionally, the apparatus is capable of performing the claimed functions.

Regarding claim 2, Reiche et al. discloses said cage is clamped to the outside of the male member by deformations (the male members lateral surfaces are deformed or

curved inwardly which aid in providing the clamping force for the fastening cage) on the lateral surface thereof.

Regarding claim 4, Reiche et al. discloses a plurality of metal strips fitted inside respective recesses of said cage (see fig.5).

Regarding claim 5, Reiche et al. discloses an intermediate shaft assembly comprising a female member (fig.5, 3) [adapted for slidably receiving a male member therein], said female and male members (fig.5, 2) having a substantially triangular shape with blunt vertexes (see fig.6, both members have a substantially triangular shape with blunt vertexes); at least one metal strip (fig.5, metal strips 9) that is separate from the male member having an uneven contact surface (the strips are uneven or not flat, furthermore any contact surface can be read as uneven since all contact surfaces have surface roughness and thus are uneven); and a fastening cage (fig.6, 7) fitted between the male member and the female member, said fastening cage having at least one recess (see figures 5 and 6, the strips are fitted between the members and in a recess 8), said fastening cage surrounding said male member (see fig.6), and said at least one metal strip being received in said at least one recess (see fig.5).

Regarding claim 6, Reiche et al. discloses a plurality of metal strips (9) fitted inside respective recesses of said cage.

Regarding claims 9 and 12, Reiche et al. discloses said male member has blunt surfaces (surfaces as seen in fig.6).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4-6, 9, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hobaugh, II (USP 6200225).

Regarding claims 1 and 5, Hobaugh II discloses an intermediate shaft assembly comprising a female member (12) [adapted for slidably receiving a male member therein], said female and male members (14); at least one metal strip (38) that is separate from the male member having an uneven contact surface (the strips are uneven or not flat, furthermore any contact surface can be read as uneven since all contact surfaces have surface roughness and thus are uneven); and a fastening cage (34, 36) fitted between the male member and the female member, said fastening cage having at least one recess (recess which hold the metal strips), said fastening cage surrounding said male member (see fig.2), and said at least one metal strip being received in said at least one recess (see fig.2).

Hobaugh II fails to explicitly disclose said male and female members having a substantially triangular shape with blunt vertexes.

Hobaugh II teaches or suggest that the number lobes or vertexes on the male and consequently female members can be greater or lesser if desired. In other words Hobaugh II suggest the possibility of changing the shape of the male or female

members. This would provide the predictable result of controlling the amount of load bearing capability of the intermediate shaft assembly.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have changed the shape of the male and female members to be substantially triangular as suggested by Hobaugh II, in order to provide the predictable result of controlling the amount of load bearing capability of the intermediate shaft assembly.

Regarding claim 2, Hobaugh discloses said cage is clamped to the outside of the male member by deformations (the male members lobers are deformed or curved which aid in providing the clamping force for the fastening cage) on the lateral surface thereof.

Regarding claim 4, Hobaugh discloses a plurality of metal strips fitted inside respective recesses of said cage (see fig.2).

Regarding claim 6, Hobaugh discloses a plurality of metal strips (38) fitted inside respective recesses of said cage.

Regarding claims 9 and 12, Hobaugh discloses said male member has blunt surfaces (surfaces are curved as seen in fig.2).

Response to Arguments

Applicant's arguments with respect to claims 1, 2, 4-6, 9, 12 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS DIAZ whose telephone number is (571)270-5461. The examiner can normally be reached on Monday-Friday 8:30am to 5:00pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on (571)272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thomas Diaz/
Examiner, Art Unit 3656

/Richard WL Ridley/
Supervisory Patent Examiner, Art Unit 3656